

BEST AVAILABLE COPY**REMARKS**

Applicant's attorney hereby affirms the provisional election made on October 5, 2005 to prosecute the claims of Invention I, i.e., claims 1-10. It is understood that claims 11-20 are withdrawn from further consideration.

Claims 1-10 stand rejected under 35 U.S.C. § 112, second paragraph, for the reasons presented by the examiner on page 4 of the outstanding office action. This rejection is respectfully traversed.

The examiner has taken the position that the term "opioid" as employed in claims 1-10 is indefinite and that compounds such as those enumerated in claim 2 "... are not considered to be opioids in the art." The undersigned attorney disagrees with the examiner on the basis that the correct term that embraces such compounds is in fact "Opioid". In support of the undersigned attorney's position, enclosed are two articles from Wikipedia®. Opioids are classified as ATC code NO2 in accordance with the Anatomical Therapeutic Chemical Classification System. Subclasses NO2AA - NO2AX clearly embrace all of the compounds recited in claim 2. Note also that the term "morphinan derivative" suggested by the examiner falls within subclass NO2AF.

The prior art clearly recognizes the term "opioid" and interchangeably uses the term "opioid agonist" and "opioid analgesic" to embrace all of the compounds recited in the instant claim 2. For example, see the following US patents: 7,078,018; 7,074,803; 6,787,149; 6,743,442; 6,716,449; 6,696,066; 6,685,964; 6,572,885; 6,294,195 and the like.

Claims 1-3 and 8-9 stand rejected under 35 U.S.C. § 102 as being anticipated by British Patent 894,609 ("GB '609"). Claims 1-10 also stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer US Patent 5,869,498 in view of GB'609.

Applicants have initiated a program to compare tannates of codeine and morphine prepared by the method described in GB'609 with the tannates of codeine and morphine prepared by the method described in the instant patent application. It is believed that there will be significant differences in the physical and chemical properties of the two types of tannates. However, applicants cannot respond to the rejections under 35 U.S.C. § 102/103(a) at this time since applicants have not yet received permission from the Drug Enforcement Agency to acquire research quantities of codeine and morphine which are controlled substances

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Applicants have, by means of the accompanying Petition To Suspend Action By The Office Under 37 C.F.R. § 1.103(a), requested a suspension of examination and prosecution of this patent application for a period of six (6) months to allow the DEA sufficient time to review assignee's request to add codeine and morphine to its existing DEA registration and to thereafter carry out the necessary comparative testing. It is anticipated that the data obtained from the comparative testing will be submitted to the Office prior to the end of the six (6) month period of suspension in the form of a Declaration Under 37 C.F.R. § 1.132 or such data will be presented in a continuation-in-part of the present application.

Respectfully submitted,



Jack Matalon
Attorney for Applicants
Reg. No. 22,441

Law Offices of Jack Matalon
32 Shelley Rd.
Springfield, NJ 07081-2529

Tel: (973) 467-5626
Fax: (973) 921-0817